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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,266	09/07/2004	Jonathan D. Albert	H-310DIV	5265
26245	7590	10/03/2006	EXAMINER PATEL, NITIN	
DAVID J COLE E INK CORPORATION 733 CONCORD AVE CAMBRIDGE, MA 02138-1002			ART UNIT 2629	PAPER NUMBER

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/711,266		ALBERT, JONATHAN D.	
	Examiner		Art Unit	
	Nitin Patel		2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-23 objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-26 of (U.S. Patent No. 6,816,147). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 1-23 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-26 of prior U.S. Patent No. 6,816,147. This is a double patenting rejection.

As per claim 1, Albert shows an electro-optic display comprising: a bistable electro-optic material having on one side thereof a viewable surface visible to an observer viewing the display, and on the opposed side thereof a writing surface; a deformable member contacting the writing surface of the electro-optic material, the deformable member having a plurality of electrodes formed on its surface contacting the writing surface of the electro-optic material; and a movable member disposed on the opposed side of the deformable member from the electro-optic material and movable

relative to the electro-optic material, the movable member urging the deformable member into contact with the electro-optic material such that movement of the movable member relative to the electro-optic material will cause the area of contact between the deformable member and the electro-optic material to move across the writing surface of the electro-optic material (in claim 1 of '147).

As per claim 2, Albert shows an electro-optic display according to claim 1 wherein the electro-optic material is an encapsulated electrophoretic material (in claim 2 of '147).

As per claim 3, Albert teaches an electro-optic display according to claim 2 wherein the encapsulated electrophoretic material comprises a plurality of capsules each of which contains one or more species of charged particles in a suspending fluid, the charged particles being capable of moving through the fluid upon application of an electric field to the material (In claim 3 of '147).

As per claim 4, Albert also teach an electro-optic display according to claim 2 wherein the encapsulated electrophoretic material comprises a plurality of capsules each of which contains, in a substantially uncolored suspending fluid, at least two species of charged particles differing in at least one optical characteristic and having differing electrophoretic mobilities, the charged particles being capable of moving through the fluid upon application of an electric field to the material 9In claim 4 of '147).

As per claim 5, Albert shows an electro-optic display according to claim 2 wherein the encapsulated electrophoretic material comprises a two-phase electrophoretic medium comprising a continuous phase and a discontinuous phase, the

discontinuous phase comprising a plurality of droplets, each of which comprises a suspending fluid and at least one particle disposed within the suspending fluid and capable of moving through the fluid upon application of an electric field to the material, and the continuous phase surrounding and encapsulating the discontinuous phase 9in claim 5 of '147).

As per claim 6, Albert shows an electro-optic display according to claim 1 wherein the electro-optic material is a rotating bichromal member material (in claim 6 of '147).

As per claim 7, Albert shows an electro-optic display according to claim 1 wherein the deformable member has the form of a thin sheet of a flexible material (in claim 7 of '147).

As per claim 8, Albert shows an electro-optic display according to claim 7 wherein the deformable member is provided with tensioning means for holding the deformable member under tension such that portions of the deformable member not in contact with the movable member will be held spaced from the electro-optic material (In claim 8 of '147).

As per claim 9, Albert shows an electro-optic display according to claim 7 further comprising a layer of liquid or pressurized gas disposed between the electro-optic material and the deformable member such that portions of the deformable member not in contact with the movable member will be held spaced from the electro-optic material (In claim 9 of '147).

As per claim 10, Albert shows an electro-optic display according to claim 1

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wherein the electrodes are formed by printing a conductive ink on to the deformable member (In claim 10 of '147).

As per claim 11, Albert shows an electro-optic display according to claim 1 wherein at least one of the deformable member and the movable member is provided with a friction-reducing layer (in claim 11 of '147).

As per claim 12, Albert shows an electro-optic display according to claim 1 wherein the movable member is rotatable such that the movable member can roll across the surface of the deformable member (in claim 12 of '147).

As per claim 13, Albert shows an electro-optic display according to claim 1 wherein at least the portion of the movable member which contacts the deformable member is itself deformable (in claim 13 of '147).

As per claim 14, Albert shows an electro-optic display according to claim 13 wherein the movable member is rotatable and comprises a substantially rigid core and a deformable sleeve surrounding the core and contacting the deformable member 9 in claim 14 of '147).

As per claim 15, Albert shows an electro-optic display according to claim 1 further comprising sealing means for preventing entry of small particles between the electro-optic material and the deformable member (in claim 16 of '147).

As per claim 16, Albert shows an electro-optic display according to claim 16 wherein the sealing means comprises a sealing member sealingly engaged with peripheral portions of both the electro-optic material and the deformable member so as to form a closed chamber between the writing surface of the electro-optic material and

the electrode-carrying surface of the deformable member (in claim 17 of '147).

As per claim 17, Albert shows an electro-optic display according to claim 15 wherein the sealing means comprises a sealed housing enclosing the electro-optic material, the deformable member and the movable member (In claim 18 of '147).

As per claim 18, Albert shows a method for addressing an electro-optic display, this electro-optic display comprising: a bistable electro-optic material having on one side thereof a viewable surface visible to an observer viewing the display, and on the opposed side thereof a writing surface; a deformable member contacting the writing surface of the electro-optic material, the deformable member having a plurality of electrodes formed on its surface contacting the writing surface of the electro-optic material; and a movable member disposed on the opposed side of the deformable member from the electro-optic material and movable relative to the electro-optic material, the movable member urging the deformable member into contact with the electro-optic material such that movement of the movable member relative to the electro-optic material will cause the area of contact between the deformable member and the electro-optic material to move across the writing surface of the electro-optic material, the method comprising: placing the movable member in a first position relative to the electro-optic material and placing a first set of potentials on the electrodes, thereby writing a first column of pixels of the display, each of this column of pixels being defined by the portion of one electrode which contacts the writing surface of the electro-optic material when the movable member is in its first position; and moving the movable member to a second position relative to the electro-optic material, this second position

being spaced from the first position, and placing a second set of potentials are placed on the electrodes, at least one of the second set of potentials differing from the first set of potentials, thereby writing a second column of pixels of the display, each of this column of pixels being defined by the portion of one electrode which contacts the writing surface of the electro-optic material when the movable member is in its second position (in claim 19 of '147).

As per claim 19, Albert shows a method according to claim 18 further comprising holding the deformable member under tension such that portions of the deformable member not in contact with the movable member are held spaced from the movable member (in claim 20 of '147).

As per claim 20, Albert shows a method according to claim 18 further comprising providing the electrodes by printing a conductive ink on to the deformable member (in claim 22 of '147).

As per claim 21, Albert shows a method according to claim 19 wherein the movable member is rotatable and rolls across the surface of the deformable member (in claim 23 of '147).

As per claim 22, Albert shows a method according to claim 21 wherein the movable member comprises a substantially rigid core and a deformable sleeve surrounding the core and contacting the deformable member (in claim 24 of '147).

As per claim 23, Albert shows a method according to claim 19 further comprising sealing the space between the electro-optic material and the deformable member to prevent entry of small particles therein (In claim 26 of '147).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nitin Patel whose telephone number is 571-272-7677. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin H. Shalwala can be reached on 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nitin Patel
Examiner
Art Unit 2629

